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MARK C. VAN NESS
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP
12400 WILSHIRE BLVD., 7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

ABRAMS, NEIL

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635051

Applicant(s)

Examiner

Group Art Unit

2839

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 8-10-03 (C/m 6/5)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 36-71, 137-139 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 36-71, 137-139 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Title is unclear.

Term PCMCIA should be used since standard for these items.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claims 48, 55, 139 features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

^{features}
These should be pointed out if present.

Claim 69, is dependency correct?

Related case paragraph pat nos or now abandoned" should ^{be} added where proper.

Note that earliest parent case does not support claims elected in this case.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Common ownership of this application at the time of the invention with Pat No. 5,773,332 to Glad and with S.N. 09/251391 is assumed.

Applicant is asked to confirm this if correct.

The parent case paragraph is objected to as improper since S.N. 09/251391 does not list Glad as co-inventor. Note that applicant has agreed to add Glad as inventor in that case.

Claims 36-71, 137-139 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,773,332 to Glad. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this case define broadened and obvious variations of the patent claims.

For example 36 of this case calls for a channel to receive a biased clip, while patent claim 1 calls for an cutout to receive the clip.

Claims 36-71, 137-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim pending of copending

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Application No. 09/251391. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this case define obvious variations of parent case claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 36 calls for a channel to receive the claim. Claim 20 of the earlier case calls for a receiving structure to receive the clip.

Claims 36, 37, 38, 41-43, 58, 60, 61, 62, 64, 65, 70, 71 137-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein in view of Okada, 479 Aldous 404, Hardesty, Roebuck and Lazarchik.

Stein discloses a system with a card 31 or 131 that is of PCMCIA type size (about 10.5 mm thick). The card does not include a rear recess with electrical conductors for receipt of an RJ plug. Aldous, fig 8, Okada, fig 20 and show cards that with recesses that receive RJ plugs with latches and that have electrical conductors. It would have been obvious to form the Stein card with a recess for such a plug. This would enable the card to be connected to phone lines.

Use of such latched plug would require addition of a channel to the recess wall as in Hardesty at 68 or Lazarchik at 60 or Aldous at 92, 94. This would be for receipt of the latch. Since size may be at issue, note that the R. J. plugs should easily be received in the Stein card back wall recess since they are small in height (seven mm disclosed by Roebuck, col 5, lines 7-15 and as disclosed by Aldous, fig 8 are fittable into a 10 mm thick ^{part} ~~par~~ 56. Should height still be at

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issue, also obvious to use side latches as in Lazarchik. This would enable plugs to more easily be fitted into narrow height cards.

For claims 37, 38 the reference channels including right angled slots as in Hardesty, fig. 7 and Aldous, fig 10 at 90, 92 are readable as being T-shaped. Obvious to use these in Stein as these are standard shapes. Other claims also met by Stein, etc applied as above.

Claims 49, 50, 59, 63, 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 36, etc above, and further in view of Tan and Japan 97652.

The Stein, etc combination discussed above does not include a second recess for an RJ plug. Aldous, fig. 2, Tan at 40 and Japan show modules with pairs of recesses for RJ plugs.

It would have been obvious to use such a pair for the Stein, etc combination in view of these teachings. This would enable more connections to be made and more data to be imputed to the computer.

Claims 36, 41, 42, 43, 58, 60, 61, 62, 64, 65, 70, 71, 137-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada 442.

Okada (see fig 6) discloses a card of 5 mm thickness (col. 12). With a recess 3 having contacts 8 and a channel 61. A plug is closely received in the recess 3 and a biased clip 25 is received in the channel 61. The card is not disclosed to be a type III. Type III cards are admittedly well known. It would have been obvious to form the card as a larger type III in order that it be able to contain more circuitry *or to be easier to make,*

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Claims 49, 50, 59, 63 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada 442 in view of Tan.


Okada does not use a pair of recesses for plugs- It would have been obvious to form the Okada card with a pair of recesses for plugs in view of Tan at 40 so that it could increase data input.

Claims 39, 40, 44-48 51-57 are allowable over prior art other than as used in the double patenting rejection.

Any inquiry concerning this communication should be directed to N Abrams at telephone number (703) 308-1729.

N ABRAMS/pj

06/19/03


NEIL ABRAMS
EXAMINER
ART UNIT 322